

REMARKS

This is a full and timely response to the outstanding Office action mailed April 26, 2005. Upon entry of the amendments in this response claims 1-34 are pending. More specifically, claims 1, 9, 15, 23, and 29 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1, 6, 15, 16, 20, 29 and 32 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Nielsen (U.S. Patent No. 6,108,688). Claim 2 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) as applied to claim 1 above in view of Gupta (U.S. Published Application No. 2002/0194341), Collins *et al.* (U.S. Published Application No. 2002/0013817) hereinafter Collins and Johnson *et al.* (U.S. Patent No. 5,832,220). Claims 3, 17 and 30 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) as applied to claims 1, 15, and 29 above, in view of Shaw *et al.* (U.S. Patent No. 6,247,045) hereinafter Shaw. Claims 4, 18 and 31 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) as applied to claims 1, 15, and 29 in view of Collins *et al.* (U.S. Published Application No. 2002/0013817) hereinafter Collins. Claims 7, 21 and 33 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) as applied to claims 6, 20 and 33 above, and further in view of Gupta (U.S. Published Application No. 2002/0194341). Claims 5, 8, 19, 22 and 34 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) as applied to claims 1, 15 and 29 above, and further in view of Johnson *et al.* (U.S. Patent No. 5,832,220). Claims 9, 13, 14, 23, 27 and 28 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Gupta (U.S. Published Application No. 2002/0194341). Claims 10 and 24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) as applied to claims 9 and 23 above, and further in view of Johnson *et al.*

(U.S. Patent No. 5,832,220). Claims 11 and 25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) as applied to claims 9 and 23 above, and further in view of Shaw *et al.* (U.S. Patent No. 6,247,045). Claims 12 and 26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) as applied to claims 9 and 23 above, and further in view of Collins *et al.* (U.S. Published Application No. 2002/0013817). These rejections are respectfully traversed.

II. Claim 2 is Clearly Allowable

Applicant first contends that no reference or combination thereof discloses or suggests claim 2 and, therefore, claim 2 is clearly allowable. Applicant respectfully submits that because of the uniqueness of the claim limitations, and especially those added to its base claim through the foregoing amendment, claim 2 is clearly allowable over all prior references. It is respectfully requested that serious consideration be given to allowing claim 2.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 1 and 6

The Office Action rejects claims 1 and 6 under 35 U.S.C. §102(e) as allegedly being anticipated by *Nielsen* (U.S. Patent No. 6,108,688). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A method for selectively applying a delivery notification option to an email comprising:
 - listing email addresses;
 - selecting a plurality of said email addresses in the course of composing an email message;

maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;

selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses;

moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and

sending the email to said plurality of email addresses.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Nielsen* does not disclose, teach, or suggest at least **moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option**.

Therefore, *Nielsen* does not anticipate independent claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited art of record, dependent claim 6 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that dependent claim 6 contains all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claim 6 is patentable over *Nielsen*, the rejection to claim 6 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 6 recites further features and/or combinations of features, as are

apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claim 6 is allowable.

B. Claims 15, 16, and 20

The Office Action rejects claims 15, 16, and 20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Nielsen* (U.S. Patent No. 6,108,688). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 15 as amended recites:

15. An email system for providing selective application of delivery notification options to individual addresses in a single email, comprising:

means for listing email addresses;

means for selecting a plurality of said email addresses in the course of composing an email message;

means for maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;

means for selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses;

means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and

means for sending the email to said plurality of email addresses.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 15 as amended is allowable for at least the reason that *Nielsen* does not disclose, teach, or suggest at least **means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.**

Therefore, *Nielsen* does not anticipate independent claim 15, and the rejection should be withdrawn.

Because independent claim 15 as amended is allowable over the cited art of record, dependent claims 16 and 20 (which depend from independent claim 15) are allowable as a matter of law for at least the reason that dependent claims 16 and 20 contain all the steps/features of independent claim 15. Therefore, since dependent claims 16 and 20 are patentable over *Nielsen*, the rejection to claims 16 and 20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 15, dependent claims 16 and 20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 16 and 20 are allowable.

C. Claims 29 and 32

The Office Action rejects claims 29 and 32 under 35 U.S.C. §102(e) as allegedly being anticipated by *Nielsen* (U.S. Patent No. 6,108,688). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 29 as amended recites:

29. An email system for selectively applying delivery notification options to an email having a plurality of addressees, comprising:

an email client operable to display an address list and to select addressees for an email; and

an email server in communication with the email client and connected to a network;

wherein at least one of the email client and the email server is operable to selectively apply a delivery notification option to one or more, but not all, of the addressees; and

wherein at least one of the email client and the email server is further operable to maintain a first list for a first type of delivery notification option and a second list for a second type of delivery notification option; and to move each of the one or more

email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 29 as amended is allowable for at least the reason that *Nielsen* does not disclose, teach, or suggest at least **wherein at least one of the email client and the email server is further operable to maintain a first list for a first type of delivery notification option and a second list for a second type of delivery notification option; and to move each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.** Therefore, *Nielsen* does not anticipate independent claim 29, and the rejection should be withdrawn.

Because independent claim 29 as amended is allowable over the cited art of record, dependent claim 32 (which depends from independent claim 29) is allowable as a matter of law for at least the reason that dependent claim 32 contains all the steps/features of independent claim 29. Therefore, since dependent claim 32 is patentable over *Nielsen*, the rejection to claim 32 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 29, dependent claim 32 recites further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claim 32 is allowable.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 2-5 and 7-8

The Office Action rejects claim 2 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Nielsen* (U.S. Patent No. 6,108,688) as applied to claim 1 above in view of *Gupta* (U.S. Published Application No. 2002/0194341), *Collins* (U.S. Published Application No.

2002/0013817), and *Johnson* (U.S. Patent No. 5,832,220). Claim 3 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Shaw *et al.* (U.S. Patent No. 6,247,045). Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Collins *et al.* (U.S. Published Application No. 2002/0013817). Claims 5 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688 and Johnson *et al.* (U.S. Patent No. 5,832,220). Claim 7 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Gupta (U.S. Published Application No. 2002/0194341). For the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-5 and 7-8 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-5 and 7-8 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 2-5 and 7-8 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-5 and 7-8 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-5 and 7-8 are allowable.

Additionally, with regard to the rejection of claims 2-5 and 7-8, *Gupta*, *Collins*, *Johnson*, and *Shaw* do not make up for the deficiencies of *Neilsen* noted above. Therefore, claims 2-5 and 7-8 are considered patentable over any combination of these documents.

B. Claims 9-14

The Office Action rejects claims 9, 13, and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Gupta (U.S. Published Application No. 2002/0194341). Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) in view of Johnson *et al.* (U.S. Patent No. 5,832,220).

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) in view of Shaw *et al.* (U.S. Patent No. 6,247,045). Claim 12 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) and Gupta (U.S. Published Application No. 2002/0194341) in view of Collins *et al.* (U.S. Published Application No. 2002/0013817). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 9 as amended recites:

9. A method of selectively applying a delivery notification option to addressees in an email, comprising:

- displaying an address book;
- choosing addressees from the address book;
- setting a flag indicating that more than one addressee has been chosen;
- displaying an email delivery notification options selection window if said flag is set;
- maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;
- selectively applying delivery notification options to each of the addressees;
- moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option;*** and
- sending the email.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 9 is allowable for at least the reason that the combination of *Nielsen* and *Gupta* does not disclose, teach, or suggest at least **moving each of the one or more email addresses with a delivery notification option**

applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 9. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 9 is allowable.

Because independent claim 9 is allowable over the cited art of record, dependent claims 10-14 (which depend from independent claim 9) are allowable as a matter of law for at least the reason that dependent claims 10-14 contain all the steps/features of independent claim 9. Therefore, the rejection to claims 10-14 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 9, dependent claims 10-14 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 10-14 are allowable.

Additionally, with regard to the rejection of claims 10-14, *Collins*, *Johnson*, and *Shaw* do not make up for the deficiencies of *Nielsen* and *Gupta* noted above. Therefore, claims 10-14 are considered patentable over any combination of these documents.

C. Claims 17-19 and 21-22

The Office Action rejects claim 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Shaw *et al.* (U.S. Patent No. 6,247,045). Claim 18 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Collins *et al.* (U.S. Published Application No. 2002/0013817). Claim 19 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Johnson *et al.* (U.S. Patent No. 5,832,220). Claim 21 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent No. 6,108,688) in view of Gupta (U.S. Published Application No. 2002/0194341). Claim 22 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielsen (U.S. Patent

No. 6,108,688) in view of Johnson *et al.* (U.S. Patent No. 5,832,220). For the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 15 is allowable over the cited art of record, dependent claims 17-19 and 21-22 (which depend from independent claim 15) are allowable as a matter of law for at least the reason that dependent claims 17-19 and 21-22 contain all the steps/features of independent claim 15. Therefore, the rejection to claims 17-19 and 21-22 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 15, dependent claims 17-19 and 21-22 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 17-19 and 21-22 are allowable.

Additionally, with regard to the rejection of claims 17-19 and 21-22, *Collins*, *Johnson*, and *Shaw* do not make up for the deficiencies of *Nielsen* noted above. Therefore, claims 17-19 and 21-22 are considered patentable over any combination of these documents.

D. Claims 23-28

The Office Action rejects claims 23-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Nielsen* (U.S. Patent No. 6,108,688), *Gupta* (U.S. Published Application No. 2002/0194341) *Johnson* (U.S. Patent No. 5,832,220) *Shaw* (U.S. Patent No. 6,247,045) *Collins* (U.S. Published Application No. 2002/0013817). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 23 as amended recites:

23. A system for selectively applying a delivery notification option to addressees in an email, comprising:

- means for displaying an address book;
- means for choosing addressees from the address book;
- means for setting a flag indicating that more than one addressee has been chosen;

means for displaying an email delivery notification options selection window if said flag is set;

means for maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;

means for selectively applying delivery notification options to each of the addressees;

means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and

means for sending the email.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 23 is allowable for at least the reason that the combination of *Nielsen, Gupta, Johnson, Shaw, and Collins* does not disclose, teach, or suggest at least **means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 23. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 23 is allowable.

Because independent claim 23 is allowable over the cited art of record, dependent claims 24-28 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24-28 contain all the steps/features of independent claim 23. Therefore, the rejection to claims 24-28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24-28 recite further features and/or combinations of features, as are

apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 24-28 are allowable.

Additionally, with regard to the rejection of claims 24-28, *Gupta, Johnson, Shaw*, and *Collins* does not make up for the deficiencies of *Nielsen* noted above. Therefore, claims 24-28 are considered patentable over any combination of these documents.

E. Claims 30-31 and 33-34

The Office Action rejects claims 30-31 and 33-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Nielsen* (U.S. Patent No. 6,108,688), in view of *Shaw* (U.S. Patent No. 6,247,045) in view of *Collins* (U.S. Published Application No. 2002/0013817) further in view of *Gupta* (U.S. Published Application No. 2002/0194341), and further in view of *Johnson* (U.S. Patent No. 5,832,220). For the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 29 is allowable over the cited art of record, dependent claims 30-31 and 33-34 (which depend from independent claim 29) are allowable as a matter of law for at least the reason that dependent claims 30-31 and 33-34 contain all the steps/features of independent claim 29. Therefore, the rejection to claims 30-31 and 33-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 29, dependent claims 30-31 and 33-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 30-31 and 33-34 are allowable.

Additionally, with regard to the rejection of claims 30-31 and 33-34, *Gupta, Johnson, Shaw*, and *Collins* does not make up for the deficiencies of *Neilsen* noted above. Therefore, claims 30-31 and 33-34 are considered patentable over any combination of these documents.

V. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-34 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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